REMARKS

The Office Action of June 13, 2005, has been considered by the Applicants. Claims 1 and 16 have been amended. Claims 1-32 are pending. Reconsideration of the Application is requested.

Claims 1-7, 16, 17, 19-22, and 30-32 were rejected under 35 U.S.C. 102(b) as anticipated by Fuller (6,200,716). Applicants traverse the rejection.

Fuller does not disclose all claim limitations. In particular, Fuller does not disclose the basic catalyst recited in the claims. Fuller describes the reduction of poly(vinylbenzyl acetate) to poly(vinylbenzyl alcohol) using a borane-tetrahydrofuran (BTHF) complex; see col. 6, lines 26-30; col. 17, lines 50-55. Fuller does not teach that borane is a "basic catalyst"; indeed, borane is a Lewis acid. Furthermore, the Examiner has not cited any prior art which indicates that borane is a basic catalyst. Please note that U.S. Patent 3,879,328, which is mentioned in paragraph [0003] of the instant specification, describes acid catalysts such as hydrochloric acid and sulfuric acid. In addition, Fuller teaches a reduction reaction, whereas the instant claims recite a hydrolysis reaction; the two reactions are not equivalent. Because Fuller does not teach all claim limitations, the claims are not anticipated. Applicants request withdrawal of the 102(b) rejection based on Fuller.

Claims 8-12 and 23-27 were rejected under U.S.C. 103(a) as unpatentable over Fuller in view of Deubzer (6,251,313). Claims 13, 14, 28, and 29 were rejected under U.S.C. 103(a) as unpatentable over Fuller in view of Pinschmidt, Jr. (6,391,992). Because these two rejections are rebutted with the same argument, Applicants traverse these rejections together.

There is no motivation to combine Fuller with either Deubzer or Pinschmidt, Jr. MPEP § 2143.01. The Examiner states that Fuller teaches the hydrolysis is performed in the presence of a "basic catalyst". (Note: the Examiner states that Pinschmidt Jr. teaches solvents; however, he teaches catalysts by his own words; see col. 8, lines 22-28.) Fuller makes no such teaching; he describes only the use of a BTHF complex and does not state what properties of that complex make it suitable for use. The words

"basic" and "catalyst" and the phrase "basic catalyst" are never used in Fuller. As stated above, the BTHF complex and the reduction reaction do not suggest using a basic catalyst in a hydrolysis reaction either. Unless the phrase "basic catalyst" is used in Fuller, one skilled in the art would not be motivated to use a different catalyst. Therefore, there is no motivation to combine the references.

Applicants submit that the Examiner's conclusion of obviousness is based on improper hindsight argument; see MPEP § 2145(X)(A). In particular, the Examiner is using the "knowledge gleaned only from [Applicants'] disclosure" that a basic catalyst is suitable for use in forming poly(vinylbenzyl alcohol). *In re McLaughlin* 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

For these reasons, Applicants request withdrawal of the rejections based on Fuller combined with either Deubzer or Pinschmidt, Jr.

Claims 3 and 18 were rejected under U.S.C. 103(a) as unpatentable over Fuller in view of Sato (5,710,211). Applicants traverse the rejections.

Initially, Applicants note that claims 3 and 18 are dependent claims. If an independent claim is non-obvious, so are its dependent claims. MPEP § 2143.03. Also as noted above, Fuller does not render the instant claims obvious. Sato does not remedy Fuller's deficiencies.

The Examiner uses Sato to teach the use of pyridine as a solvent, stating that Sato discloses a process for producing vinyl alcohol-type polymers. Applicants note that Sato does not teach a vinylbenzyl alcohol polymer in his reactions; indeed, Sato intends to teach the addition of functional groups to a vinyl alcohol polymer. Further, Sato teaches the use of pyridine as a reaction catalyst for a reaction between (A) a vinyl ester polymer having an epoxy group and (B) a compound having a thiol or thioester group. These starting reactants are very different from the poly(vinylbenzyl acetate) recited in the independent claims; no reason is given by Sato or the Examiner to believe that a catalyst suitable for these reactants are suitable as solvents for the reactants in the instant application. Sato also teaches specific solvents for his reaction; see col. 4, lines 57-62. Therefore, one skilled in the art would not read Sato and learn that pyridine

is a suitable solvent. For these reasons, the combination of Fuller and Sato does not render claims 3 and 18 obvious. Applicants request withdrawal of the rejection.

With regards to the amendment of claims 1 and 16, Applicants note that reciting a reaction mixture with the two components listed has basis in the specification and original claims. In claim 16, the misspelled word "poly(vimyl" was corrected. This correction does not change the scope of claim 16.

CONCLUSION

For the reasons given above, Applicants submit the pending claims (1, 3-16, and 18-32) are in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, she is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

It is believed that no fee is due in conjunction with this response. If, however, it is determined that fees are due, authorization is hereby given for deduction of those fees, other than the issue fees, from Deposit Account No. 24-0037.

Respectfully submitted,

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